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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,587	03/29/2004	Osamu Nakamura	042234	9493

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EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT PAPER NUMBER

1773

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/810,587	NAKAMURA ET AL.	
	Examiner	Art Unit	
	D. S. Nakarani	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11 are, drawn to a gas barrier laminated film, classified in class 428, subclass 516+.
 - II. Claims 12-15 are, drawn to a process for producing a gas barrier laminated film, classified in class 264, subclass 173.16+.
2. The inventions are independent or distinct, each from the other because:
3. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by materially deferent process such as performing claimed barrier layer film and bonding to a preformed substrate film using adhesive such as polyurethane, modified polypropylene.
4. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

5. The election of Group I require further election as follows:

6. This application contains claims directed to the following patentably distinct species: substrate of claim 4, i.e. biaxially stretched polyester film or of claim 5, i.e. biaxially stretched polypropylene film. The species are independent or distinct because the gas barrier film of claim 4 requires search in class/subclass 428/483 and the gas barrier film of claim 5 requires search in class/subclass 428/520.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3 and 6-9 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

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7. During a telephone conversation with Mr. Ken-Ichi Hattori on March 3, 2006 a provisional election was made with traverse to prosecute the invention of Group I and species of claim 5, i.e. biaxially stretched polypropylene film as a substrate film, claims 1-3 and 5-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4 and 12-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

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9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11, line 2, the phrase "modified propylene polymer" lacks clear antecedent basis. No modified propylene polymer has been previously recited. Therefore limitation cannot be understood.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-3 and 5-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murai et al (U. S. Patent 5,770,301) in view of Breant et al (U. S. Patent

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5,712,041), Watanabe et al (U. S. Patent 5,693,424) and Super et al (U. S. Patent 4,501,797).

Murai et al disclose a barrier composite comprising biaxially stretched polypropylene coated with primer layer such as vinyl chloride-vinyl acetate copolymer (Col. 4, lines 45-50 and col. 5, lines 16-32), silicon oxide layer over the under coating and barrier coating ethylene vinyl alcohol copolymer (EVOH) having ethylene content from about 5 to 50 mol% over the silicon oxide layer (Col. 7, line 61 to col. 8, line 7 and claim 18). Murai et al also addition of acrylic polymer to the barrier layer forming EVOH coating composition (Col. 8, lines 22-30). Murai et al also disclose that modified polypropylene and vinyl chloride-vinyl acetate copolymer as being equivalent (Col. 10, line 62 to col. 11, line 20), Murai et al fail to disclose a blend of claimed EVOH and (meth)acrylic acid polymer and polypropylene/modified polypropylene composite.

Breant et al disclose bonding heat sealable layer to the silicon oxide coated biaxially stretched film using a mixture of EVOH and copolymer of ethylene with unsaturated carboxylic acids, their salt or their esters for improved barrier properties (Col. 3, line 14 to col. 4, line 26, and Table under Example 1).

Watanabe et al disclose a mixture of EVOH and thermoplastic resin containing an unsaturated carboxylic acid such as methacrylic acid or acrylic acid (Col. 9, lines 5-16, and Examples).

Super et al disclose a gas barrier film comprising biaxially stretched polypropylene layer 12, modified polypropylene layer 14 and barrier EVOH layer 16 (Fig. 1, col. 4, lines 4-10).

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Therefore it would have been obvious to a person of ordinary skill in the art at the time of this invention made to utilize disclosures of Breant et al, Watanabe et al and Super et al in the invention of Murai et al to use as under layer of modified polypropylene and to use a mixture of EVOH and (meth)acrylic acid polymer as taught by Breant et al and Watanabe et al. Murai et al's EVOH encompasses claimed EVOH.

No claims are allowed.


14. Receipt of Information Disclosure Statement filed July 27, 2004 is acknowledged and has been made of record. All non-English documents have been considered to the extent of either provided English abstract or provided explanation in the present specification.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


D. S. Nakarani
Primary Examiner
Art Unit 1773

DSN
March 5, 2006.